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REMARKS/ARGUMENTS

Claims 1-10 are pending in this application. By this Amendment, Applicant AMENDS claim 1 and ADDS claim 10.

Applicant submits this Supplemental Amendment under 37 C.F.R. § 1.111(a)(2) and MPEP § 714.03(a). Applicant respectfully submits that this Supplemental Amendment does not unduly interfere with any Office Action being prepared in response to the previous Amendment filed on August 28, 2003. Accordingly, Applicants respectfully request that this Supplemental Amendment be entered.

Applicant has amended claim 1 to remove the feature of "the electrode duty of the parallel arm resonator is about 0.51 to about 0.55." Applicant has added claim 10 to recite this feature.

Applicant hereby incorporates the Remarks/Arguments made in the previous Amendment filed on August 28, 2003 to the extent that they are not Inconsistent with the Remarks/Arguments provided herein.

Claims 1, 2 and 4-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishihara et al. (U.S. 5,796,205) in view of Applicant's Admitted Prior Art (AAPA). Applicant respectfully traverse the rejection of claims 1, 2, and 4-9.

Claim 1 has been amended to recite:

"A surface acoustic wave filter comprising:
a piezoelectric substrate; and
a plurality of one-terminal-pair surface acoustic resonators
disposed on said piezoelectric substrate, each of the plurality of one-terminal-pair surface acoustic resonators including interdigital electrodes disposed on said piezoelectric substrate, and **an insulating film deposited on and adhered to the interdigital electrodes;**
wherein at least one of said plurality of one-terminal-pair surface acoustic resonators is a series arm resonator, and at least one of the remaining one-terminal-pair surface acoustic resonators is a parallel arm resonator,
the series arm resonator and the parallel arm resonator are coupled in a ladder arrangement,
the electrode duty of the parallel arm resonator is greater than the

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electrode duty of the series arm resonator, the electrode duty of a one-terminal pair surface acoustic resonator being defined by the following equation (1):

$$\text{electrode duty} = 2 \times W/\lambda \quad \dots(1)$$

where λ denotes the wavelength of the one-terminal-pair surface acoustic wave resonator, and W denotes the line width of an interdigital electrode." (emphasis added)

Applicant's claim 1 recites the feature of "an insulating film deposited on and adhered to the interdigital electrodes." With the improved features of claim 1, Applicant has been able to provide a surface acoustic wave filter which requires one deposition of an insulating film in order to achieve the desired frequency adjustment without degrading the frequency bandwidth (see, for example, the paragraph bridging pages 5 and 6 of the originally filed Specification).

Applicant agrees with the Examiner that Nishihara et al. fails to teach or suggest that feature of an insulating film deposited on and adhered to the interdigital electrodes as recited in Applicant's claim 1. The Examiner has relied upon AAPA to allegedly cure this deficiency.

Nishihara et al. teaches away from depositing and adhering an insulating film to the interdigital electrodes as recited in Applicant's claim 1 because it clearly teaches that a heat-treated ion implantation layer should be used instead of an insulating film. The Examiner is reminded that it is error to find obviousness where references diverge and teach away from the invention at hand. W.L. Gore & Assoc. v. Garlock Inc., 220 USPQ 303, 311 (Fed. Cir. 1983). Lines 52-55 of column 1 of Nishihara et al. discloses that "[i]n FIG. 1B, an insulating film 4 is formed on the surface of the piezoelectric substrate 1 (or the surface of the piezoelectric thin film) on which the comb-type electrode 2 is formed." Fig. 1B of Nishihara et al. clearly shows that the insulating film 4 is formed on the comb-type electrode 2. Lines 20 and 21 of column 2 of Nishihara et al. discloses that "[t]he variation of the second method shown in FIG. 1B has disadvantages similar to those of the second method." Nishihara et al. describes those

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disadvantages in the first paragraph of column 2 as being a large insertion loss, absorption and damping of the SAW device, and the sensitivity of the electromechanical coupling factor to the thickness of the insulation film. In order eliminate these disadvantages, Nishihara et al. teaches, for example, in line 40 of column 2 the use of a heat-treated ion implantation layer, instead of the insulating film 4 in Fig. 1B. Thus, Nishihara et al. specifically teaches away from an insulating film deposited on or adhered to the interdigital electrodes.

Therefore, contrary to the Examiner's allegations, one of ordinary skill in the art would not have modified the device of Nishihara et al. to include "an insulating film deposited on and adhered to the interdigital electrodes" as recited in Applicant's claim 1 because Nishihara et al. explicitly teaches away from such an arrangement.

As noted above, the Examiner cannot ignore Nishihara et al.'s clear teachings away from using an insulating film. The Examiner is reminded that it is impermissible within the framework of 35 U.S.C. § 103(a) to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391 (CCPA 1965). Thus, the Examiner must consider the portions of Nishihara et al. that clearly teach away from using an insulating film.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Nishihara et al. in view of AAPA.

Accordingly, Applicant respectfully submits that none of the prior art of record, applied alone or in combination, teaches or suggests the unique combination and arrangement of elements recited in claim 1 of the present application. Claims 2 and 4-9 depend upon claim 1 and are therefore allowable for at least the reasons that claim 1 is allowable. The Examiner has indicated that claim 3 is allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits

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that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

Applicant previously petitioned the Commissioner for a THREE-month extension of time, extending to August 28, 2003, the period for response to the Office Action dated February 28, 2003, with the Amendment filed August 28, 2003.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: November 6, 2003



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